

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:	)	
	)	
Michael D. Zoeckler	)	Examiner: Harmon, Christopher R.
	)	
Serial No.: 09/559,704	)	Art Unit: 3721
	)	
Filed: April 27, 2000	)	Confirmation No.: 2557
	)	
For: PAPERBOARD CARTONS WITH	)	
LAMINATED REINFORCING RIBBONS	)	
AND TRANSITIONED SCORES AND	)	
METHOD OF MAKING SAME	)	

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**REPLY BRIEF**

Sir:

This Reply Brief is filed pursuant to 37 CFR 41.41, in response to the Examiner's Answer dated January 28, 2010 (hereinafter the "New Examiner's Answer" or "Answer")<sup>1</sup>, which adds new grounds of rejection. In accordance with 37 CFR 41.39(b)(2), Applicant requests that the appeal be maintained. The new grounds of rejection are addressed in this Reply Brief.

**RELATED APPEALS AND INTERFERENCES (UPDATED)**

On May 30, 2007, the Board of Patent Appeals and Interferences entered a Decision on

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<sup>1</sup> The previous Examiner's Answer, dated October 23, 2009, was vacated by the Office Action dated January 11, 2010, which in turn was vacated by the New Examiner's Answer dated January 28, 2010.

Appeal in this application, reversing the rejection of claims 1-7, 9-16 and 25-34 (Appeal No. 2007-0809). A copy of that decision is included in the Related Proceedings Appendix of the Appeal Brief filed on September 21, 2009 ("Appeal Brief").

U.S. Patent Application Nos. 11/620,918 and 12/020,859 are both continuations of U.S. Patent Application No. 09/818,023 (abandoned), which was a continuation-in-part of the present application. U.S. Patent Application Nos. 11/620,918 and 12/020,859 now are both currently under appeal.

### **STATUS OF CLAIMS**

Claims 1-3, 5-7, 9-11, 13-15, 25-29, 31-33 and 77-81 are pending.

Claims 4, 8, 12, 16-24, 30, and 34-76 have been cancelled.

Claims 1-3, 5-7, 9-11, 13-15, 25-29, 31-33 and 77-81 are rejected, and their rejections are being appealed.

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

This appeal was taken from the following grounds of rejection in the Office Action dated May 19, 2009:

- (1) Claims 1, 5-7, 11, 13, 25, 31-33 and 77, anticipated by *Walsh* (U.S. Patent 5,746,871) (*Walsh*), under 35 U.S.C. § 102(b).
- (2) Claims 1, 5-7, 11, 13, 25, 31-33 and 77, unpatentable over *Walsh*, under 35 U.S.C. § 103(a).
- (3) Claims 9 and 10, unpatentable over *Walsh* in view of *Decottignies et al.* (U.S. Patent No.

5,097,651) (*Decottignies*), under 35 U.S.C. § 103(a).

(4) Claims 78-81, unpatentable over *Walsh* in view of *Meyers* (U.S. Patent No. 4,177,715) (*Meyers*), under 35 U.S.C. § 103(a).

The New Examiner's Answer adheres to the foregoing grounds of rejection and adds the following New Grounds of Rejection:

(5) Claims 3 and 29, anticipated by *Walsh*, under 35 U.S.C. § 102(b).

(6) Claims 3 and 29, unpatentable over *Walsh*, under 35 U.S.C. § 103(a).

(7) Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33 and 77, unpatentable over *McNown* (U.S. Patent No. 5,447,270) (*McNown*) in view of *Walsh*, under 35 U.S.C. § 103(a).

(8) Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33 and 77, unpatentable over *McNown* in view of *Claff* (U.S. Patent 2,008,608) (*Claff*)<sup>2</sup>, under 35 U.S.C. § 103(a).

All of the foregoing grounds of rejection (1) – (8) are to be reviewed on appeal.

It is noted initially that on page 10 of the Answer, the Examiner cites three U.S. patents (*Mathieu et al.*, No. 6,015,084; *Balin*, No. 4,905,864; and *Knecht*, No. 5,393,295). Although Applicant does not consider that these patents are any more relevant than the prior art applied by the Examiner in grounds of rejection (1)-(8), Applicant objects to the citation of these patents in the Answer, since they are not positively included in any of the stated grounds of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); Ex parte Raske, 28 USPQ2d 1304, 1305 (BPAI 1993).

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<sup>2</sup> *Claff* is a reference that was applied when prosecution was reopened following the Board's May 30, 2007, decision in this case. During subsequent prosecution, the Examiner dropped *Claff* as a basis for rejection, but has now resurrected it in this new ground of rejection.

## **ARGUMENT**

### **A. RESPONSE TO GROUNDS OF REJECTION (1) TO (4)**

For the reasons discussed in the Appeal Brief filed on September 21, 2009, Applicant contends that these rejections are not well taken, and requests that they be reversed. However, the Board is requested also to consider the following remarks, which are submitted in response to assertions and arguments presented in the New Examiner's Answer.

Before discussing the grounds of rejection individually, it is worth noting that the Examiner continues to exhibit a fundamental misunderstanding of the function performed by *Walsh's* ribbons (strips) 6. Even if, as stated by the Examiner on page 9 of the Answer, the ribbons 6 would "inherently provide additional structural reinforcement", the purpose of the ribbons, as discussed by Applicant on pages 6 and 7 of the Appeal Brief, is not reinforcement, but rather to prevent portions 64 of the paperboard web 2 from adhering to film 10. The Examiner's failure to acknowledge the intended purpose of *Walsh's* ribbons pervades the rejections in this case and renders them untenable.

#### **Ground (1): Anticipation by *Walsh***

On pages 7-13 of the Appeal Brief, Applicant explained how *Walsh* does not anticipate independent claims 1 and 25, because *Walsh* does not disclose at least the claimed limitations of (i) longitudinal fold lines in the web, and (ii) ribbons which do not extend across longitudinal fold lines.

With regard to limitation (i), the Examiner states that "Walsh clearly depicts longitudinal

fold lines as noted supra” and that “The web is advanced as claimed” (Answer, pages 9-10). However, as pointed out in the Appeal Brief (page 7), although *Walsh* discloses an advancing web, it does not disclose longitudinal fold lines 54 in the advancing web. As far as can be determined, it appears rather that in the *Walsh* process, ribbons 6 are applied to the advancing web 2 (see Fig. 1 and col. 3, lines 5-11), and that fold lines 54 are formed when the carton blank (Fig. 5) is formed. In contrast, independent claims 1 and 25 recite a method of advancing a web of noncorrugated paperboard that has panel portions separated by longitudinal fold lines, and the ribbons are then adhered or laminated to the advancing web.<sup>3</sup> Thus, *Walsh* does not meet limitation (i) since longitudinal lines are not formed in the web prior to adhering ribbons, as claimed.

*Walsh* also does not meet limitation (ii). Applicant explained in detail on pages 8-13 of the Appeal Brief not only why it is not inherent in the *Walsh* process that the ribbons do not extend across the longitudinal fold lines, but moreover why one of ordinary skill in the art would conclude that they do so extend. The Examiner, however, contrary to precedent cited in the Appeal Brief,<sup>4</sup> maintains that the claims are anticipated by *Walsh* even though he states that “The disclosure [of *Walsh*] is not clear as to the exact positioning of the ribbons of reinforcing material with respect to fold lines 54” (Answer, page 4). Since there can be no anticipation by inherency unless “the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art,” *Trinitec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d

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<sup>3</sup> On pages 9-10 of the Answer, the Examiner mistakenly states that Applicant is relying on the unclaimed feature of “performing a folding process prior to adhering ribbons of reinforcing material”. Applicant is not relying on any such feature, nor could he, since Applicant’s disclosed process specifies that the ribbons are adhered to the web before carton blanks are formed from the web and folded into cartons.

<sup>4</sup> *In re Lind*, 264 F.2d 914, 916, 121 USPQ 222, 223 (CCPA 1959); *In re Turlay*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962)

1949, 1950-51 (Fed. Cir. 1999)), Applicant cannot understand how a claimed feature can be “necessarily present” in a reference when according to the Examiner it is “not clear” whether the reference discloses that feature.

On pages 10-11 of the Answer, the Examiner draws an inference that *Walsh*’s ribbons (strips) 6 do not cross longitudinal fold lines 54 from the fact that *Walsh* discloses that fold lines 54 are formed in material 2, but fails to mention that they are formed in ribbons 6. However, no conclusion can be drawn from this “non-disclosure”, because *Walsh* also does not mention that fold lines 54 are formed in film 10, even though film 10 covers the entire width of the web 2, including fold lines 54.

Since *Walsh* does not disclose at least limitations (i) and (ii), it cannot anticipate the claims.

### **Ground (2): Obvious over *Walsh***

First, concerning limitation (i) above, the Examiner entirely fails to assert that it would have been obvious to provide longitudinal fold lines in the advancing web 2 of *Walsh*.

Regarding limitation (ii) above, the incorrectness of the Examiner’s conclusion as to why it would have been obvious not to extend the *Walsh* ribbons 6 beyond the longitudinal fold lines was addressed fully on pages 13-15 of the Appeal Brief. The Examiner’s position seems to be that it would have been obvious not to extend the so-called “reinforcing ribbons” of *Walsh* across the longitudinal fold lines in order to avoid folding problems. However, not only does *Walsh* fail to reference folding problems, but also the Examiner fails to recognize that *Walsh*’s ribbons 6 are not provided for the purpose of reinforcement. As demonstrated in the Appeal Brief, in order for ribbons 6 to perform their intended function of preventing the film 10 from adhering to the

paperboard 2, they must cross the longitudinal fold lines. In this regard it is well settled that “If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)” MPEP 2143.01, part V. If the *Walsh* method were modified as proposed by the Examiner, ribbons 6 would no longer perform the function for which they are provided; therefore, the proposed modification of *Walsh* would not have been obvious.

Accordingly, independent claims 1 and 25, together with dependent claims 5-7, 11-13, 31-33 and 77, are patentable over *Walsh*. Likewise, dependent claims 9, 10 and 78-81 are patentable, since *Decottignies* and *Meyers* do not overcome the deficiencies of *Walsh*.

**Ground (3): *Walsh* in view of *Decottignies***

The Examiner’s response to Applicant’s arguments concerning this ground of rejection (Appeal Brief, pages 15-16) is that they are “merely speculative” (Answer, page 11). Citing *KSR Int’l. Inc. v. Teleflex Inc.*, 550 U.S. 398, 417, 82 USPQ2d 1385, 1396 (2007), the Examiner states that “one must ask whether the improvement is more than the predictable use of prior art elements according to their established functions” (ibid.). Insofar as this question relates to the proposed combination of *Walsh* and *Decottignies*, the answer is “yes”. The “established function” of *Decottignies*’ printed indicia on top film 5 is to function as a label (col.2, lines 3-4), and the top film is positioned on the exterior of the container (see Figs. 3A-3D and col.3, lines 20-24). This is not a “predictable use” insofar as it relates to the ribbons 6 of *Walsh*, since, as discussed on page 15 of the Appeal Brief, it is inapplicable to the *Walsh* ribbons, which are not on the exterior of the carton. Moreover, as noted on pages 15-16 of the Appeal Brief, even if

*Walsh* were modified as proposed by the Examiner, claim 9 (and claim 10) would still not be met.

**Ground (4): *Walsh* in view of *Meyers***

This ground of rejection is not sustainable, since *Meyers* does not overcome the above-discussed deficiencies of *Walsh*.

**B. RESPONSE TO NEW GROUNDS OF REJECTION (5) TO (8)**

**Ground (5): Claims 3 and 29, Anticipated by *Walsh***

Claims 3 and 29, which are dependent on independent claims 1 and 25, respectively, are not anticipated by *Walsh* for the reasons provided above and the reasons provided in the Appeal Brief with respect to ground of rejection (1).

**Ground (6): Claims 3 and 29, Obvious Over *Walsh***

Claims 3 and 29 are not obvious over *Walsh* for the reasons provided above and the reasons provided in the Appeal Brief with respect to ground of rejection (2).

**Ground (7): Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33 and 77, Obvious Over *McNown* in view of *Walsh***

*McNown* discloses a method of reinforcing a container (box) made of corrugated material, in which paperboard, particularly in the form of strips or patches, is laminated to the



container. *Walsh*, as discussed above, discloses laminating ribbons 6 to a web 2 of paperboard prior to forming carton blanks from the web. The Examiner takes the position that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the progressive lamination manufacturing techniques as taught by Walsh in the invention to McKnown [sic] in order to reinforce edge panel portions with a reduced amount of material and high structural integrity.  
(Answer, page 7)

It is noted initially that the ribbons 6 of *Walsh* are not provided for the purpose of reinforcement; see the discussion above in the Response to Grounds of Rejection (1) to (4). However, assuming for the sake of argument that it would have been obvious to make the carton blank of *McNown* from a web of material to which reinforcing strips have been laminated, the combination of *McNown* in view of *Walsh* still fails to render obvious the subject matter of the appealed claims.

In the first place, *McNown* only discloses the use of reinforcing laminations on a box made of corrugated material; see Abstract, line 2; col. 1, lines 11 and 16; col. 2, lines 6, 7, 17 and 18; col. 3, lines 20 and 30; claims 1 and 5. The appealed claims, on the other hand, all require a web of noncorrugated paperboard. This is consistent with one of the aspects of Applicant's invention, which is to provide a method of making a paperboard carton which has enhanced strength and rigidity relative to a carton made of "micro-flute" (corrugated) material, at a competitive cost (Specification, p. 7, line 20 to p. 8, line 18). There is no teaching or suggestion in *McNown* that the process disclosed therein is usable with cartons made of noncorrugated paperboard.

Second, step (a) of claims 1 and 25 recites, inter alia:

advancing a web of noncorrugated paperboard along a path, the web of noncorrugated paperboard having . . . longitudinally extending panel portions that will each become a plurality of panels, the longitudinally extending panel portions being separated by longitudinal fold lines (emphasis added).

*Walsh* does not show any fold lines in the illustration of web 2 in Fig. 2, or disclose that longitudinal fold lines 54 are present in web 2. As far as can be determined, the fold lines 54 are not formed until the carton blank (Fig. 5) is formed from the web (col. 3, lines 42-48). Since *McNown* does not disclose a web, and *Walsh* does not disclose an advancing web of paperboard having longitudinal panel portions separated by longitudinal fold lines as claimed, *McNown* as modified by *Walsh* does not meet step (a) of claims 1 and 25.

Third, neither *McNown* nor *Walsh* discloses, teaches, or suggests the limitations in step (b) of independent claims 1 and 25, i.e.:

the first ribbon and the second ribbon having a width less than the width of the web of noncorrugated paperboard, the first ribbon being positioned to overlie and adhere to substantially all of, but not beyond, a first selected longitudinally extending panel portion of the web, and the second ribbon being positioned to overlie and adhere to substantially all of, but not beyond, a second selected longitudinally extending panel portion of the web, the first ribbon and the second ribbon not extending across the longitudinal fold lines (claim 1)

the first ribbon and the second ribbon having a width less than the width of the web of noncorrugated paperboard, the first ribbon being positioned on, and adhered to, substantially all of, but not beyond, a first longitudinally extending panel portion of the web of noncorrugated paperboard, and the second ribbon being positioned on, and adhered to, substantially all of, but not beyond, a second

longitudinally extending panel portion of the web, the first ribbon and the second ribbon not extending across the longitudinal fold lines (claim 25)

Claims 1 and 25 cover at least two configurations disclosed by Applicant: a first configuration in which at least the first reinforcing ribbon overlies substantially all of a longitudinally extending edge panel portion lying between a longitudinal fold line and an edge of the web (see, e.g., ribbon 62 between fold line 53 and the edge of the web 55 in Fig. 3), and a second configuration in which at least the first ribbon overlies substantially all of a longitudinally extending intermediate panel portion between two longitudinal fold lines (see, e.g., ribbon 123 on panel 117 between fold lines 125 in Fig. 8). In both configurations, the ribbon overlies substantially all of, but not beyond, the longitudinally extending panel portion, and does not extend across the longitudinal fold line(s).<sup>5</sup>

*Walsh's* disclosure is not relevant to the claimed position of the ribbons relative to the longitudinal fold lines, because *Walsh* does not disclose that ribbons 6 (which are not provided for the purpose of reinforcement) do not extend across longitudinal fold lines 54. In fact, as explained on pages 8-14 of the Appeal Brief, it is evident from *Walsh's* disclosure that ribbons 6 do extend across longitudinal fold lines 54. Consequently, *Walsh* does not teach or suggest the above-quoted limitations in step (b) of claims 1 and 25.

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<sup>5</sup> In its May 30, 2007, decision in this application, the Board construed the expression “panel portion of the web” as: “a portion of the web that will become a panel separated by fold lines in completed paperboard cartons or carton blanks. In other words, a ‘panel portion of the web’ is a portion of the web that corresponds to a panel in the completed carton” (pp. 4-5). The Board also interpreted the term “substantially all” in the claim language “substantially all of a selected [longitudinally extending] panel portion of the web” as: “... directed to Appellant’s preferred embodiment, illustrated in Figs. 3-5, wherein the reinforcing ribbon overlies and is adhered to the entirety of a panel portion, except for a predetermined short distance between its inboard edge and an adjacent folding line, the predetermined short distance selected to allow unimpeded folding of the carton blank while maximizing structural reinforcement.” (p. 6)

*McNown* apparently discloses three embodiments for reinforcing a box panel 2 which is connected to flaps via score lines 6: (1) a first embodiment in which reinforcing material 4 is laminated to the “full width” of panels with flaps (Figs. 3A - 3C; col. 2, lines 51-53); (2) a second embodiment in which the reinforcement strips are laminated to the flaps, and across the score lines (Figs. 1B, 4A, 4B; col. 2, lines 45-48 and 54-56)<sup>6</sup>; and (3) a third embodiment in which lamination strips are provided on panels “just inside” the score lines (Figs. 1C, 5A, 5B; col. 2, lines 45-48 and 57-59).<sup>7</sup> Embodiment (1) is clearly not relevant to the present case since reinforcement as presently recited is not over the full width of the web. With regard to embodiments (2) and (3), it is not clear to Applicant whether the Examiner is relying on embodiment (2) or (3) as evidence of obviousness, since on page 6 of the Answer he refers to Fig. 1C and portions of *McNown*’s specification directed to embodiment (3), but on page 7 of the Answer he states (as quoted previously) that it would have been obvious to use the techniques taught by *Walsh* “in the invention to *McNown* in order to reinforce edge panel portions.” Applicant will therefore address both possibilities.

With regard to embodiment (2), *McNown* does not disclose or suggest that the reinforcing laminations do not extend across the score lines 6. To the contrary, in the embodiments of *McNown* in which the laminations 4 cover the flaps, they extend across the score lines 6; see Figs. 1B, 4A and 4B.<sup>8</sup> Also, it is noted that in *McNown*’s discussion of panels tested with flaps, *McNown* only refers to “full width” lamination, “partial lamination across the score line,” and laminations “just inside the flap score lines” (col. 4, line 62 to col. 5, line 5). *McNown* does not

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<sup>6</sup> Although *McNown* states at col. 2, lines 54-56, that Fig. 4C illustrates “laminations across score lines,” no laminations appear to be shown in that figure.

<sup>7</sup> Although *McNown* states at col. 2, lines 57-59, that Fig. 5C illustrates “laminations inside score lines,” no laminations appear to be shown in that figure, which seems to be identical to Fig. 4C.

<sup>8</sup> See footnote 6.

teach or suggest laminations outside the score line (i.e., only on the flap), but rather teaches that “laminations 4 across the score lines separated the effect of load transfer at score lines 6 from reinforcement of high stress areas” (col. 3, lines 42-44). Also, *McNown* discloses at col. 4, lines 62-66, that:

For the panels tested with flaps, where the lamination crossed the score line, strength improvement is 11% for a three inch coverage on the panel. This shows that the lamination acted to suppress failure in the panel and improved load transfer at the score line.

Thus, *McNown* not only does not disclose the use of laminations which cover only the flaps and do not cross the score lines, but actually teaches away from using such an arrangement, because such laminations would not provide improved load transfer at the score lines, an intended purported benefit of the cartons of *McNown*.

*McNown*'s embodiment (3) involves an arrangement in which the reinforcing strips 4 are laminated on a panel 2 “just inside” the score lines 6 (see Fig. 1C; col. 3, lines 36-38) and “inside” score lines on panels with flaps (Figs. 5A and 5B; col. 2, lines 57-59).<sup>9</sup> The terms “just inside” and “inside” are subject to interpretation since *McNown* fails to state in his specification or show in his drawings whether the intention of these terms is to indicate that the laminations do not extend across the score lines. Also, *McNown* does not disclose that the laminations are spaced from the fold lines, let alone that they are so spaced from the fold lines that they would meet the requirement in the Board's interpretation of “substantially all” (see footnote 5, *supra*) of being spaced from the fold lines a “predetermined short distance selected to allow unimpeded folding of the carton blank while maximizing structural reinforcement”.

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<sup>9</sup> See footnote 7.

However, even assuming that the laminations in *McNown*'s embodiment (3) are so spaced from the fold lines, *McNown*'s embodiment (3) does not meet or render obvious the ribbon arrangement claimed by Applicant. Assuming that *McNown*'s panel 2 would correspond to a "longitudinally extending panel portion" as recited in independent claims 1 and 25, embodiment (3) of *McNown* would not meet the appealed claims' recitation of adhering first and second ribbons to first and second longitudinally extending panel portions, respectively, since *McNown*'s laminations 4 are both adhered to the same panel 2. Moreover, claims 1 and 25 both recite that each of the first and second ribbons overlies or is positioned on substantially all of, but not beyond, first and second longitudinally extending panel portions, respectively. In *McNown*, however, neither of the laminations 4 on panel 2 covers substantially all of, but not beyond, panel 2.

Accordingly *McNown*, even if modified in view of *Walsh*, does not disclose, suggest or otherwise render obvious the subject matter recited in claims 1-3, 5-7, 11, 13-15, 25-29, 31-33 and 77.

Claims 6 and 33

These claims are patentable over *McNown* in view of *Walsh* for the same reasons as given above with respect to their respective parent claims 1 and 25. Additionally, claims 6 and 33 are patentable in their own right, since there is no disclosure or suggestion in *McNown* of adhering a reinforcing lamination on top of another reinforcing lamination. Moreover, such a modification of *McNown* would not have been obvious in view of *Walsh*, since not only are *Walsh*'s ribbons 6 not provided for the purpose of reinforcement, but also there is no disclosure or teaching of adhering a ribbon of reinforcing material on top of another lamination of reinforcing material.

Claims 7 and 32

Claims 7 and 32 are patentable over *McNown* in view of *Walsh* for the same reasons as discussed above with respect to their respective parent claims 1 and 25. Additionally, claims 7 and 32 are patentable in their own right. Both claims are drawn to a method in which the first ribbon is positioned or applied to a panel portion that is intermediate the opposed edges of the web. As discussed above relative to *McNown*'s embodiment (3), *McNown* does not disclose such an arrangement. Rather, *McNown* discloses (e.g., in Fig. 1C) two laminations 4 on the intermediate panel portion between score lines 6. *McNown* does not disclose that the first ribbon overlies or is positioned on substantially all of, but not beyond, the intermediate panel portion, nor that a second ribbon overlies or is positioned on substantially all of, but not beyond, a second panel portion, as claimed.

**Ground (8): Claims 1-3, 5-7, 11, 13-15, 25-29, 31-33 and 77, Obvious Over *McNown* in view of *Claff***

The rejected claims are no more unpatentable over the combination of *McNown* in view of *Claff* than they are over the combination of *McNown* in view of *Walsh*. *Claff*, unlike *Walsh*, discloses that the tapes (ribbons) 2 are provided for the purpose of reinforcing the web 1. However, like the ribbons 6 of *Walsh*, *Claff*'s ribbons 2 extend over longitudinal score lines 6; in fact, they are provided for the purpose of reinforcing the corners, i.e., the score lines, of the box (p. 1, col. 1, lines 33-38; p. 2, col. 1, lines 15-21).

First, as with above-discussed new ground of rejection (7), *McNown* only discloses the use of reinforcing laminations on a box made of corrugated material; see Abstract, line 2; col. 1, lines 11 and 16; col. 2, lines 6, 7, 17 and 18; col. 3, lines 20 and 30; claims 1 and 5. The

appealed claims, on the other hand, all require a web of noncorrugated paperboard. This is consistent with one of the aspects of Applicant's invention, which is to provide a method of making a paperboard carton which has enhanced strength and rigidity relative to a carton made of "micro-flute" (corrugated) material, at a competitive cost (specification, p. 7, line 20 to p. 8, line 18). There is no teaching or suggestion in *McNown* that the process disclosed therein is usable with cartons made of noncorrugated paperboard.

Second, the combination of *McNown* and *Claff* does not meet the recitation of independent claims 1 and 25 that the web has longitudinally extending panel portions separated by longitudinal fold lines. There are no longitudinally extending fold lines 6 in *Claff*'s web 1 when the ribbons 2 are applied. In fact, *Claff* specifically discloses at p. 1, col. 2, lines 44-47, that the lines 6 are scored "After the tape has been applied to the opposed edge portions of the web 1." See also p. 2, col. 2, lines 18-24 and 39-47.

Third, modifying the method of *McNown* in view of *Claff* by applying *McNown*'s reinforcing laminations 4 to a web of paperboard and then cutting the web into carton blanks, even if considered obvious, would not meet or render obvious all the limitations of claims 1 and 25. As discussed above with regard to new ground of rejection (7), *McNown* (embodiment (2)) does not suggest applying laminated strips to the flaps without the strips extending across longitudinal score lines 6. In fact, *McNown* teaches that the laminations should extend across the score lines. Similarly, *Claff* discloses that the ribbons 2 that cover the flaps 10 extend across longitudinal score lines 6. Moreover, as noted above, *Claff* does not teach or suggest that ribbons 2 should not extend across score lines 6, since their purpose is to reinforce the score lines.

Also as discussed with regard to new ground of rejection (7), *McNown* (embodiment (3))



does not teach or suggest applying a lamination to the panel portion between the score lines 6 that would overlie or be positioned on substantially all of, but not beyond, the panel portion. Moreover, if *McNown* were considered to teach such an arrangement, the claims would still not be met because there would not be a second ribbon overlying or positioned on substantially all of, but not beyond, a second longitudinal panel portion.

Accordingly *McNown*, even if modified in view of *Claff*, does not disclose, suggest or otherwise render obvious the subject matter recited in claims 1-3, 5-7, 11, 13-15, 25-29, 31-33 and 77.

Claims 7 and 32


Claims 7 and 32 are patentable over *McNown* in view of *Claff* for the same reasons as discussed above with respect to their respective parent claims 1 and 25. Additionally, claims 7 and 32 are also patentable in their own right, since both claims are drawn to a method in which the first ribbon is positioned or applied to a panel portion that is intermediate the opposed edges of the web. As discussed above relative to *McNown*'s embodiment (3), *McNown* does not disclose such an arrangement. Rather, *McNown* discloses (e.g., in Fig. 1C) two laminations 4 on the intermediate panel portion between score lines 6. *McNown* does not disclose that the first ribbon overlies or is positioned on substantially all of, but not beyond, the intermediate panel portion, nor that a second ribbon overlies or is positioned on substantially all of, but not beyond, a second panel portion.

**Conclusion**

For the reasons given above and in the Appeal Brief, the subject matter of the appealed claims is not unpatentable over the grounds of rejection applied by the Examiner in the Office action of May 19, 2009, nor over the new grounds of rejection applied in the New Examiner's Answer. It is therefore respectfully requested that the rejections of claims 1-3, 5-7, 9-11, 13-15, 25-29, 31-33 and 77-81 be reversed.

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Reply Brief to Deposit Account No. 09-0528.

Respectfully submitted,



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